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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/992,914	12/18/97	WATANABE E	0020-4348P

HM22/1014

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EXAMINER
ZAGHMOUT, U

ART UNIT	PAPER NUMBER
1649	17

DATE MAILED: 10/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/992,914

Applicant(s)
Watanabe et al.

Examiner
Ousama Zaghmout

Group Art Unit
1649



☒ Responsive to communication(s) filed on 7-30-1999, 9-17-1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 6, 7, 9-18, 31-36, 40, 41, 43, and 44 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 6, 7, 9-18, 31-36, 40, 41, 43, and 44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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OFFICE ACTION

1. The after final amendment has been received on 7-30-1999 and entered in part [14].

Only the amendment of the claims has been entered.

2. The after final amendment has been received on 9-17-1999 and entered [16].
3. Claims 5, 8, 19-29, 37-39 and 42 have been canceled [Paper No. 14].
4. Claims 43-44 have been newly added [Paper No. 14].
5. Claims 6, 9, 12, 13, 17, 18, 40, 41 have been amended [Paper No.16].
6. Claims 1-4, 6-7, 9-18, 31-36, 40-41, 43-44 are pending.
7. The finality of the previous Office action is withdrawn because of new grounds of rejection.
8. In view of the new grounds of rejection, the allowance of claims 1-4, 6-7, 9-18, 31-36, 40-41 has been withdrawn.

9. The after final amendment has been received on 7-30-1999 and entered in part [14].

Only the amendment of the claims has been entered. However, the amendment of the specification has not been entered. A substitute specification is required because the number and the nature of the amendments filed 7-30-1999 render it difficult to consider the case. Because of the very large number of amendments to the specification, the amendment was not entered. Therefore, a substitute specification is required.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If

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the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

NEW GROUNDS OF REJECTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-7, 9-18, 31-36, 40-41, 43-44 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 16-22 of copending Application No. 09/301,766. Although the conflicting claims are not identical, they are not patentably distinct from each other because of overlapping in the scope. As claims 1 and 2 in the instant application are directed to a nucleotide sequences which encode raffinose synthase enzyme and host cells transformed by said sequences, they read on

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claims 1-11, 16-22 of claims the copending application. In addition, the nucleotide sequence of claim 1 of the copending application is hybridizable to all sequences in claims 1-4, 6-7, 9-18, 31-36, 40-41, 43-44 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed.

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Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.

September 20, 1999